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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,936	08/09/2002	Jutta Glock	PH/5-31140A	4690

26748 7590 10/06/2004

SYNGENTA CROP PROTECTION, INC.  
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EXAMINER

QAZI, SABIHA NAIM

ART UNIT PAPER NUMBER

1616

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/070,936

**Applicant(s)**

GLOCK ET AL.

**Examiner**

Sabiha Qazi

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Final Office Action**

Acknowledgement is made of the response filed on 7/15/04. Amendments are entered. Claims 1-7 are pending. No claim is allowed at this time.

This application is a 371 of PCT/EP00/08658 filed on 9/5/2000.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejection of claims 1-7 under 35 U.S.C. 112, second paragraph is withdrawn because arguments are found persuasive.
3. Rejection of claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,410,480 (Muhlebach et al.) and. WO 98/13361 (Tobler et al) is maintained because the arguments are not found persuasive. The arguments regarding WO 99/47525 and WO 96/21652 are irrelevant because there is no rejection over this reference. It is unclear why Applicants are making the arguments over these references. Rejections were made over the two references cited above. There was no rejection over WO 99/47525 or WO 96/21652.
4. The disclosure contains only example clofinafop showing synergism. Considering broad claim 1 the application does not meet the requirements of Art. 5 of PCT, the disclosure do not illustrate or demonstrate the synergistic effect of all the ingredients or reasonable number of ingredients. Therefore, the application lacks sufficient disclosure, that one skilled in the art may be able to use all the claimed invention as in claim 1.

5. A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See *In re Riat et al.* (CCPA 1964) 327 F.2d 685, 140 USPQ 471; *In re Barr et al.* (CCPA 1971) 444 F.2d 349, 151 USPQ 724.

6. A single species is seldom, if ever, sufficient to support a generic claim. *In re Shokal*, 242 F.2d 771, \_\_\_, 113 U.S.P.Q. 283, 285 (C.C.P.A. 1957). See also, *In re Grimme*, 274 F.2d 949, \_\_\_, 124 U.S.P.Q. 499, 501 (C.C.P.A. 1960) (the naming of a member of a genus or subgenus is not a proper basis for claiming the whole group).

Objective evidence of nonobviousness must be commensurate in scope with the scope of the claims. *In re Tiffin*, 171 USPQ 294. A showing limited to a single species can hardly be considered probative of the invention's nonobviousness in view of the breadth of the claims.

7. Claims 1-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,410,480 (Muhlebach et al.) and. WO 98/13361 (Tobler et al.). Both the references cited above teach combinations of pyrazilinnone and method of controlling weeds and grasses, which embraces Applicant's claimed invention.

8. WO reference teach an antidote compound of formula (I) and their combination with a herbicidally effective amount of a herbicide such as sulfonylureas (see formula II to VI), see last four lines on page 34; See especially formula V when A2 and B2 can be Hydrogen and alkoxyalkyl group. Same substituents are R4 and R5 are in claim 1 of the present invention. See last para on page 45, 2<sup>nd</sup> para on page 46, examples and claims. See also table B1 on page 57 and Table B2-B3 on 58 and Table B4 and B5 on page 59.

Art Unit: 1616

9. US '480 teaches the herbicidal composition of the compounds as in present claim 1. See the entire document especially lines 20-67, col. 16; compound 1.01 in col. 76; examples and claims.

10. Presently claimed invention is drawn to the compositions of the compound of formula I and a safener and an herbicidal synergistic amount of the various class of compounds listed in claim 1 part (b).

11. Instant claims differ from the cited references in their generic scope. Presently claimed invention is broader than the prior art.

12. It would have been obvious to one skilled in the art at the time of invention to prepare additional beneficial combination of compositions of formula 1 and herbicides because prior art teaches pyrazoline herbicides and their combination with other active herbicides as presently claimed.

13 WO reference teaches the post-emergence phytotoxic activity of the herbicide Clodinafop (Table B1) and the data of post emergent activities of the Clodinafop with an antidote are listed in Table B2. Similarly various data with sulfonylurea and other herbicides are listed. Compound 1.01 in col. 76 of US Patent is same as presently claimed. Prior art teaches the excellent activity of this compound. Prior art also teaches that these compounds can be used with other active compounds. (lines 20 and 21 in col. 16).

Since the compounds, composition and method of use of the compound of Formula I is taught, it would have been obvious to one skilled in the art to prepare the compositions useful as herbicides to control the grass and weeds because prior art teaches the same use for these combinations.

14. No synergistic results are seen in the disclosure. It has been established that single species is seldom, if ever, sufficient to support a generic claim. Objective evidence of nonobviousness must be commensurate in scope with the scope of the claims. In re Tiffin, 171

USPQ 294. A showing limited to a single species can hardly be considered probative of the invention's nonobviousness in view of the breadth of the claims.

15. A proviso in claim 1 (last line in part a) of the claim has been noted. What prior is disclaimed?

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 205 USPQ 1069.

There is nothing inventive in a composition of old ingredients of known properties with each ingredient functioning individually as expected. *In re Sussman*. 58 USPQ 262. *In re Shokal*, 242 F.2d 771, 113 USPQ 283, 285 (C.C.P.A. 1957), See also *In re Grimme*, 274 F. 2d 949, 124 USPQ 499, 501 (C.C.P.A 1960) (the naming of a member of a genus or subgenus is not a proper basis for claiming the whole group).

For the reasons cited above there has been ample motivation provided by the prior art to prepare the compositions as claimed.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill might reasonably infer from the teachings. *In re opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA 1976). A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

Accordingly, the burden of proof is upon applicants to show that instantly claimed subject matter is different and unobvious over those taught by prior art. See *In re Brown*, 173 USPQ 685, 688; *In re Best*, 195 USPQ 430 and *In re Marosi*, 218 USPQ 289, 293.

16. In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

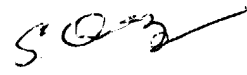
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monday, October 4, 2004



Sabiha N. Qazi  
Primary Examiner  
Art Unit 1616